

REMARKS

I. Introduction

Claims 1-12, 14-28, 30-53, 59-64, and 81-87 are currently pending in the present application. Claims 1, 30, 47, 49, 51-53, 59, 63-64, 81, and 85-86 are independent. All claims stand rejected. In particular,

(A) claims 1-4, 6-9, 11-12, 14-25, 28, 30-33, 35-38, 40-44, and 46-53 stand rejected under 35 U.S.C. §102(e) for allegedly being anticipated by U.S. Patent Publication No. 2002/0049631 (hereinafter “Williams”);

(B) claims 59-64 and 81-87 stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Williams in view of U.S. Patent No. 6,017,063 (hereinafter “Nilssen”);

(C) claims 5, 10, 34, and 39 stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Williams in view of U.S. Patent No. 5,970,470 (hereinafter “Walker”); and

(D) claims 26-27, and 45 stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Williams in view of U.S. Patent No. 4,723,212 (hereinafter “Mindrum”).

Upon entry of this amendment, which is respectfully requested, claims 1, 30, 47, 49, 51-53, 59, 63-64, 81, and 85-86 will be amended and new claims 88-108 will be added. No new matter is introduced by this amendment.

Applicants hereby respectfully request reexamination and reconsideration of the pending claims in light of the amendments and remarks provided herein and in accordance with 37 C.F.R. §1.112.

II. Interview Summary

Initially, Applicants thank Supervisory Patent Examiner John Hayes and Examiner Igor Borissov for taking the time to speak with Applicants’ representatives on May 18, 2006. Based on the insights provided by Supervisory Patent Examiner John Hayes and Examiner Igor Borissov, Applicants now have a much clearer understanding of the current grounds for rejection with respect to the Williams reference, and

Applicants believe that this paper should most appropriately place all pending claims in condition for allowance *or in stronger form for appeal.*

In particular, because Examiner Igor Borissov believed that the original claims failed to preclude the price for the benefit from being interpreted as one in the same as the price the customer pays to consummate a transaction (e.g., a transaction in which the benefit is offered), Applicants provide (despite Applicants' ardent belief that the original claims properly described the currently claimed embodiments) amendments herein directed to advancing prosecution by clarifying the pending claims.

III. Response to Arguments

Applicants note that the pursuant to MPEP §707.07(f), the Examiner "must provide clear explanations of all actions taken by the examiner during prosecution of an application." This includes, for example, "tak[ing] note of the applicant's argument and answer[ing] the substance of it." MPEP §707.07(f). In the absence of such actions by the Examiner, it cannot be clear that the Examiner has actually even considered Applicants arguments.

In the present case, the Examiner has repeatedly failed to address Applicants arguments. Instead, the Examiner states that Applicants' arguments are moot with respect to the "new grounds for rejection." Office Action mailed on April 28, 2006 as Part of Paper No./Mail Date 20060424, pg. 12, lines 5-7. Applicants respectfully note that **no new grounds of rejection has been apparent** with respect to most pending claims in the present case (since prosecution began in October of 2002) since most if not all rejections have *always* been based upon an apparently consistent interpretation of the Williams reference.

Accordingly, Applicants request that the arguments presented in all previous Responses and Appeal Briefs finally be addressed and considered by the Examiner.

IV. The Examiner's Rejections

A. 35 U.S.C. §102(e) – Williams

Claims 1-4, 6-9, 11-12, 14-25, 28, 30-33, 35-38, 40-44, and 46-53 stand rejected under 35 U.S.C. §102(e) for allegedly being anticipated by Williams. Applicants traverse this ground for rejection as follows.

Applicants note that Williams describes providing coupons *freely* to customers (i.e., Williams does not charge customers for the coupons it gives out). While Applicants believe the above-listed claims distinguished over Williams prior to the current amendments (e.g., because Williams does not determine *any* price for the benefit), Applicants nonetheless provide the clarifying amendments herein intended solely to advance prosecution by reciting explicitly that the price charged for the benefit is not the price that the customer is already paying to consummate the purchase (which Williams *clearly* does not teach)¹.

Accordingly, as Williams fails to teach or suggest limitations of claims 1-4, 6-9, 11-12, 14-25, 28, 30-33, 35-38, 40-44, and 46-53, Applicants respectfully request that the §102(e) rejections of claims 1-4, 6-9, 11-12, 14-25, 28, 30-33, 35-38, 40-44, and 46-53 be withdrawn.

B. 35 U.S.C. §103(a) – Williams, Nilssen

Claims 59-64 and 81-87 stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Williams in view of Nilssen. Applicants traverse this ground of rejection as follows.

As described in Section A herein, Williams simply fails to teach or suggest charging a price for a benefit, where the price is not the price that the customer is already paying pursuant to a transaction.

¹ Applicants note that the amendments made herein are solely clarifying in nature. In other words, while it should have been clear in the original claims that the price being charged for the benefit is different than the transaction price, the current amendments should clarify this feature as recited in the currently claimed embodiments.

Nilssen simply fails to make up for the deficiencies of Williams. Nilssen, for example, does not contemplate charging a price for a benefit at all, much less as recited in the currently claimed embodiments.

Further, Applicants respectfully direct the Examiner's attention to the previous Response filed in this case (which is hereby incorporated by reference herein) that describes how the Examiner has grossly misinterpreted the teachings of the Nilssen reference, as well as how the Examiner has grossly failed to set forth a *prima facie* case for obviousness.

At least for these reasons, the Examiner continues to fail to establish a *prima facie* case of obviousness for claims **81-87**, and fails to set forth a *prima facie* case for obviousness for claims **59-64**. Accordingly, Applicants respectfully request that the §103(a) rejections of claims **59-64** and **81-87** be withdrawn.

C. 35 U.S.C. §103(a) – Williams, Walker

Claims **5, 10, 34, and 39** stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Williams in view of Walker. As this is the same ground for rejection that the Examiner has relied upon in rejecting claims **5, 10, 34, and 39** since the first Office Action of October 3, 2002, Applicants direct the Examiner's attention to the plurality of arguments submitted in all previous Responses and Appeal Briefs, to which the Examiner has heretofore refused to address or acknowledge. Claims **5, 10, 34, and 39** are also believed to be patentable at least for depending upon patentable base claims.

D. 35 U.S.C. §103(a) – Williams, Mindrum

Claims **26-27** and **45** stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Williams in view of Mindrum. As this is the same ground for rejection that the Examiner has relied upon in rejecting claims **26-27** and **45** since the second Office Action of October 21, 2003, Applicants direct the Examiner's attention to the plurality of arguments submitted in all previous Responses and Appeal Briefs, to which the Examiner has heretofore refused to address or acknowledge. Claims **26-27** and **45** are also believed to be patentable at least for depending upon patentable base claims.

V. New Claims

New claims **88-108** are believed to be patentable over the cited references at least for the reasons otherwise presented herein. Further, after reviewing the cited references, Applicants believe that the cited references fails to teach, suggest, or render obvious at least:

- (i) *determine a price for said benefit, wherein said price is a non-zero monetary amount that is different than the first transaction price* (claims **88-99**; generally);
- (ii) *establish a benefit having a first price, wherein said first price is a non-zero monetary amount that is different than the transaction price* (claims **100-101**);
- (iii) *offer said customer an opportunity to purchase said at least one product during a second transaction for a second transaction price that is equivalent to said first transaction price* (claims **102-103**);
- (iv) *provide said customer a benefit during said first transaction, wherein said benefit allows said customer to purchase said at least one product during a second transaction for a second transaction price that is equivalent to said first transaction price and charge said customer for a cost of the benefit, wherein the charging is for an amount that is different than the first or second transaction prices* (claims **104-105**);
- (v) *wherein the information relating to the first transaction is received by the customer device and wherein the customer device comprises a mobile terminal* (claim **106**);
- (vi) *wherein the information relating to the first transaction is received from the customer device and wherein the customer device comprises a mobile terminal* (claim **107**);
- (vii) *determining, during the second transaction and on behalf of the customer, that a current price of the product is less then or equal to the second price* (claim **108**); or
- (viii) *providing an indication, based on the determining that the current price of the product is less then or equal to the second price, that the benefit should be saved for a future transaction* (claim **108**).

VI. Conclusion

At least for the foregoing reasons, it is submitted that all claims are now in condition for allowance, *or in better form for appeal*, and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remain any questions regarding the present application or the cited reference, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number 203-461-7017 or via electronic mail at cfincham@walkerdigital.com, at the Examiner's convenience.

VII. Fees and Petition for Extension of Time to Respond

While no fees are believed to be due at this time, please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, while no extension of time to respond is believed to be necessary, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

Respectfully submitted,

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Date

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